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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/473,383	12/28/1999	DOMINIC J. MOREA	06920-0120	9919

7590 06/11/2004

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EXAMINER

O CONNOR, GERALD J

ART UNIT	PAPER NUMBER
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3627

DATE MAILED: 06/11/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/473,383

Applicant(s)

Morea et al.

Examiner

O'Connor

Art Unit

3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on June 12, 2003 (RCE and Amdt "B").
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-15, 17-20, 22-24, and 26-46 is/are pending in the application.
- 4a) Of the above, claim(s) none is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15, 17-20, 22-24, and 26-46 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on Nov 8, 2002 is: a) ☒ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some\* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_ 6) ☐ Other:

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on June 12, 2003 (Paper N<sup>o</sup> 10) has been entered.

### ***Preliminary Remarks***

2. This Office action responds to the amendment and arguments filed by applicant on June 12, 2003 (Paper N<sup>o</sup> 10) in reply to the Office action mailed March 11, 2003.

3. The amendment of claims 1, 4, 17, 19, 22, 24, 26, 29, 34, 39, 40, 42, and 43, and the addition of claims 45 and 46 by applicant, in Paper N<sup>o</sup> 10, are hereby acknowledged.

### ***Claim Objections***

4. Claims 15, 20, and 24 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim.

The test as to whether a claim is a proper dependent claim is that it shall include every limitation of the claim from which it depends (35 U.S.C. 112, fourth paragraph), or, in other

words, that it shall not conceivably be infringed by anything which would not also infringe the basic claim.

When, as here, an independent claim recites a particular method, a dependent claim drawn to an apparatus capable of performing the method of the independent claim is not a proper dependent claim if the apparatus might be used in other ways, since the dependent claim (the apparatus) could conceivably be infringed without infringing the basic claim (the method), in violation of the infringement test for proper dependency of claims. See MPEP § 608.01(n)(III).

Applicant is required to cancel the claim(s), amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

5. Claims 26-44 and 46 are objected to because it is unclear if applicant intended the “structure to” recitations therein to be interpreted in the special manner accorded to “means for” recitations under 35 U.S.C. 112, sixth paragraph, or in some other manner. Applicant is required to amend the “structure to” recitations in the claims to “means for” *and/or* explicitly set forth for the record whether or not applicant intends the recitations to be interpreted in the manner provided by 35 U.S.C. 112, sixth paragraph, and, if yes, show that even though the phrase “means for” is not used, the claim limitation is written purely as a function to be performed and does not recite sufficient structure, material, or acts for achieving the specified function. See MPEP § 2181.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

7. Apparatus claims 26-44 and 46 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Zirkel (US 6,135,349). Note that, in making this rejection, the extensively recited functional language has been deemed merely intended usage of the invention, hence, afforded little patentable weight. The actual structural elements recited by the claims include merely “structure,” followed by an extensive description of intended usage that the recited element of “structure” is envisaged to perform, for example, “to receive information from the applicant completing an application for the merchant account.”

*The manner of operating a device does not differentiate apparatus claims from the prior art.* A claim containing a “recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus” if the prior art apparatus teaches all the *structural* limitations of the claim. *Ex parte Masham*, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987) (The preamble of claim 1 recited that the apparatus was “for mixing flowing developer material” and the body of the claim recited “means for mixing ..., said mixing means being stationary and completely submerged in the developer

material". The claim was rejected over a reference which taught all the structural limitations of the claim for the intended use of mixing flowing developer. However, the mixer was only partially submerged in the developer material. The Board held that the amount of submersion is immaterial to the structure of the mixer and thus the claim was properly rejected.).

*Apparatus claims must be structurally distinguishable from the prior art.* Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than function. *In re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). "[A]pparatus claims cover what a device *is*, not what a device *does*." *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990) (emphasis in original).

For further exposition regarding the lack of relevance, hence, patentable weight, of functional language in apparatus claims, refer to MPEP §2114.

### ***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-15, 17-20, 22-24 and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over the admitted prior art, as described in the written specification, in view of Zirkel (US 6,135,349), and further in view of Kannady et al. (US 5,263,164).

As described by applicant, the instant invention is a method of using the Internet, by means of appropriate computer hardware and software, to perform an otherwise conventional, well known method for activating a merchant account, accomplishing the same result as had heretofore been accomplished via manual means.

However, Zirkel discloses a similar method of activating a merchant account, and the method of Zirkel indeed includes activating the merchant account by means of the Internet, using appropriate computer hardware and software.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the conventional manual method of activating a merchant account described by applicant, so as to allow a merchant to activate a merchant account by means of the Internet, using appropriate computer hardware and software, in accordance with the teachings of Zirkel, in order to improve the efficiency of the merchant account application/ordering process, by having the merchant input all of the required application information, thereby saving time by reducing the amount of manual effort required on the part of the account provider, and also allowing the merchant to apply at any time convenient for the merchant, independent of the hours of the account provider, thereby increasing sales/profits for the account provider.

Regarding the configuration of the terminal with the user's account information/setting, Kannady et al. disclose a system and method whereby point-of-sale hardware, and software appropriate/required for operating the hardware, is chosen remotely with the software being

configured remotely with the user's account information/settings so that the point-of-sale equipment is ready for the user to use.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have further modified the method described above, so as to configure the selected hardware with the software necessary to operate the hardware, and to configure the software with the user's account information/settings, all in accordance with the teachings of Kannady et al., in order to provide the point-of-sale equipment to the user in a turnkey, ready-to-use state, thereby increasing the convenience to the user, hence the desirability and likelihood of a user selecting the point-of-sale equipment and merchant-account vendor over a competitor.

### ***Response to Arguments***

10. Applicant's arguments filed June 12, 2003 have been fully considered but are not persuasive.

11. The arguments regarding the previous prior art rejections have been considered, but have been rendered moot by applicant's amendment, and the consequent new grounds of rejection.



***Conclusion***

12. The prior art made of record and not relied upon is considered pertinent to the disclosure.

13. Any inquiry concerning this communication, or earlier communications, should be directed to the examiner, **Jerry O'Connor**, whose telephone number is **(703) 305-1525**, and whose facsimile number is **(703) 746-3976**.

The examiner can normally be reached weekdays from 9:30 to 6:00.

Inquiries of a general nature or simply relating to the status of the application should be directed to the receptionist, whose telephone number is **(703) 308-1113**.

If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Mr. Robert Olszewski, can be reached at **(703) 308-5183**.

Official replies to this Office action may be submitted by any *one* of fax, mail, or hand delivery. **Faxed replies are preferred and should be directed to (703) 872-9306** (fax-back auto-reply receipt service provided). Mailed replies should be addressed to "Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450." Hand delivered replies should be left with the receptionist on the seventh floor of Crystal Park Five, 2451 Crystal Dr, Arlington, VA 22202.

GJOC

June 4, 2004

 (6-4-04)

Gerald J. O'Connor

Patent Examiner

Group Art Unit 3627